

Response

The claims were amended in accordance with the amendments above. All of the amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved.

In the Office Action dated 07/10/2006, claims 39-40, 42, 44-47, 51, 54, 57-58, 60, and 62-66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Assisi (US 5,696,488) in view of Bexten (US 6,205,133). Claims 41, 43, 49, 52, 53, 55-56, 61, and 67 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Assisi (US 5,696,488) in view of Bexten (US 6,205,133) and Evans, III (US 5,732,231). Applicant respectfully traverses all rejections.

Under MPEP 2143.03, in order to establish a *prima facie* case of obviousness, the prior art reference or combination of references must teach or suggest all of the limitations of a claim. A *prima facie* case of obviousness also requires that there be some teaching, suggestion, or motivation to modify the references either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In view of the foregoing requirements for a *prima facie* case of obviousness, Applicant submits that the combined art of record fails to render the amended claims obvious. In particular, Applicant notes that the combination of references fails to teach or suggest all of the limitations of each amended claim in accordance with MPEP 2143.03. In addition, Applicant submits that even if the combined art of record taught or suggested all of the limitations of each present claim, there is no teaching, suggestion, or motivation to modify or combine the references to obtain the invention presently claimed, such that a *prima facie* case of obviousness has not been, and cannot be, established in accordance with MPEP 2143.01.

With respect to amended independent claim 39, Applicant notes that the claim recites “providing a life pack to a person associated with a deceased person, wherein the life pack

comprises: i) requests for the person associated with the deceased person to provide particular types of biographical information relating to the deceased person, and ii) instructions, to the person associated with the deceased person, regarding how to provide the requested particular types of biographical information relating to the deceased person in response to the requests.” Applicant submits that the combined art of record fails to teach or suggest such limitations. The Office has relied on Assisi as purportedly teaching a life pack. However, Applicant respectfully maintains that neither Assisi nor any of the other cited references teaches a life pack as claimed, particularly how the life pack is used in connection with the person associated with the deceased person. Indeed, the combined art of record is silent regarding requests *for a person associated with a deceased person* to provide *particular types of biographical information relating to the deceased person*. In other words, contrary to the suggestion by the Office, the life pack recited in claim 39 includes requests for *a person* to provide information, not simply requests to inanimate objects such as a “communication device” or a “control chamber.” Accordingly, the combined art of record fails to render amended independent claim 39 obvious in accordance with MPEP 2143.03, and the rejection should therefore be withdrawn.

With respect to amended independent claim 52, Applicant notes that the claim recites “an outdoor kiosk located outdoors within the cemetery.” Applicant respectfully submits that the combined art of record fails to teach or suggest these limitations. Applicant notes that the Office has relied upon Evans III for teaching a kiosk. However, to the extent that Evans III teaches a kiosk, Evans III teaches such a kiosk as being located *in a funeral home or other funeral establishment*; whereas amended independent claim 39 teaches a kiosk being located *outdoors within a cemetery*. Applicant submits that one of ordinary skill in the art would immediately recognize the differences between a funeral home/establishment and a cemetery; and that Evans III therefore fails to teach or suggest the claimed kiosk located in a cemetery. None of the other prior art references of record make up for this deficiency of Evans III. Accordingly, the combined art of record fails to render amended independent claim 52 obvious in accordance with MPEP 2143.03, and the rejection should therefore be withdrawn.

With respect to amended independent claim 61, Applicant notes that the claim recites “an outdoor kiosk located outdoors within the cemetery, wherein the kiosk comprises the

transmitter.” Thus, for at least the reasons set forth above regarding amended independent claim 52, a *prima facie* case of obviousness cannot be established against amended independent claim 61 in accordance with MPEP 2143.03 based on the art of record. Furthermore, there is no teaching or suggestion within the combined art of record to provide a transmitter within a kiosk as recited in amended independent claim 61. Applicant therefore respectfully requests that the rejection be withdrawn.

Furthermore, even if the combined art of record taught or suggested all of the elements of any of the amended claims, the art is devoid of any suggestion or motivation to modify or combine the teachings of the references in order to obtain the claimed invention. Indeed, MPEP 2143.01 admonishes that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (emphasis in original). *Actual evidence* of a suggestion, teaching or motivation to combine prior art references must be shown. *In re Dembiczak*, 50 USPQ2d 1614 (Fed.Cir. 1999). Instead of showing a proper motivation to combine all of the teachings in the prior art necessary to obtain the presently claimed invention, with such motivation predating the priority date of the present application, the Office instead relies on a subjective opinion by an individual Examiner, rendered more than nine years after the priority date of the present application. Applicant respectfully submits that this constitutes impermissible hindsight reconstruction, and therefore cannot properly constitute the motivation to combine required by MPEP 2143.01.

The absence of a motivation to combine the teachings of the references is further reinforced by the fact that Bexten is non-analogous art with respect to Assisi and Evans III. Applicant maintains its arguments set forth in the response filed 04/21/2006 that the Office’s characterization of the field of endeavor as “accessing information resource via radio communication” is impermissibly overbroad. *See In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992) (finding the Patent Office’s characterization of the field of endeavor impermissibly overbroad). Applicant also notes that the overbroad characterization is impermissibly inconsistent with Applicant’s full disclosure. *See In re Bigio*, 381 F.2d 1320, 1326 (Fed. Cir. 2004) (admonishing that characterizations of the field of endeavor must be based on the Applicant’s full disclosure). The Office has failed to reconcile the inconsistency of its characterization of the field of

endeavor with Applicant's full disclosure. Instead, the Office has simply shifted its characterization of the field of endeavor from "presenting information to a user" to "accessing information resource via radio communication" without any apparent regard to Applicant's full disclosure. As previously noted by Applicant, those of ordinary skill in any art would recognize that the teachings of Bexten are in the art of wireless communication network architectures, whereas Assisi and Evans III are in the art of storing and retrieving information related to a deceased person. These fields of endeavor are clearly not the same fields of endeavor as required by MPEP 2141.01(a). Applicant further maintains that the lumping of Bexten with Assisi and Evans III as being in the same field of endeavor is inconsistent with Applicant's full disclosure. Because the cited references represent such non-analogous art, and in accordance with MPEP 2141.01(a), it would not have been obvious to one of ordinary skill in the art to combine their teachings.

Furthermore, even if the combined references were properly regarded as analogous, the Office's position on motivation to combine is defective under MPEP 2143.01. With respect to the "life pack" limitations of claim 39, the Office has purported to articulate a motivation to request information from the control chamber storage. (See Office Action dated 07/10/2006 at p. 15). The Office has provided no motivation whatsoever to request for *a person* to provide information as recited in the "life pack" limitations of claim 39. A person and a "control chamber storage" are clearly different, and motivation with respect to the latter will not automatically carry over to motivation with respect to the former. Applicant maintains that there is insufficient motivation within the art at the time of the invention to provide the life pack comprising requests for a person associated with the deceased person to provide particular types of biographical information relating to the deceased person as recited in claim 39. The Office has therefore failed to establish a sufficient motivation to obtain all of the limitations recited in claim 39 in accordance with MPEP 2143.01.

With respect to the "kiosk" limitations of claims 52 and 61, the Office has stated that "the control storage chamber of Assisi's which is located at the cemetery could be designed in kiosk fashion to accommodate access of information about the deceased person from family members and others." (See Office Action dated 07/10/2006 at p. 15)(emphasis added). As noted above,

the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP 2134.01. The Office's position clearly amounts to an "obvious to try" rationale, which is explicitly forbidden and insufficient under the law of obviousness. MPEP 2145. Applicant maintains that there is insufficient motivation within the art at the time of the invention to provide the kiosk in the cemetery as recited in each of claims 52 and 61. The Office has therefore failed to establish a sufficient motivation to obtain all of the limitations recited in each of claims 52 and 61 in accordance with MPEP 2143.01.

Ultimately, the Office Action fails to provide the requisite *evidence* in the prior art suggesting the desirability of the combinations claimed herein, but instead relies solely on conclusory statements and impermissible hindsight reconstruction, without proper regard to particulars recited in the claims, and citing non-analogous art. Because the motivation required by MPEP 2143.01 is lacking, Applicant respectfully requests that the rejections be withdrawn.

Beyond the foregoing shortcomings with respect to the independent claims, Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for novelty and non-obviousness.

To the extent that the present amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and preserves all rights and arguments. While Applicant has noted several distinctions over the art of record, Applicant notes that several other distinctions exist, and Applicant preserves all rights and arguments with respect to such distinctions.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance.

Respectfully Submitted,



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